

REMARKS

The following remarks are being filed in response to the Office Action dated July 17, 2008. Claims 9-15, 17-20 and 24-28 were pending in the present application with claims 9-15 and 25-28 being allowed. Applicants note that claims 17-20 and 24 were previously allowed or indicated as containing allowable subject matter in view of the cited prior art of record. None of the pending claims currently stand rejected in view of any prior art rejections.

Claims 17-20 and 24 were rejected in the Office Action under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants respectfully traverse this rejection based on the following remarks and it is respectfully submitted that claims 9-15, 17-20 and 24-28 are in proper condition for allowance.

Claim Rejections Under 35 U.S.C. § 101

Claims 17-20 and 24 are directed to a motion picture film copy or a motion picture film print bearing special marks having the appearance of defects in order to impart coded identification information into the motion picture film copy or a motion picture film print.

35 U.S.C. § 101 recites:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

A motion picture film copy or a motion picture film print is a “manufacture” that falls within a statutory category of patent eligible subject matter under § 101. Applicants respectfully set forth that a motion picture film copy is an article of manufacture and not merely a compilation of data that could be considered an abstract idea. Applicants further note that the USPTO Board of Patent Appeals and Interferences has held that a sound recording falls within the scope of an article of manufacture under § 101. *Ex Parte Carver*, 227 U.S.P.Q. 465 (Bd. Pat. App. & Interferences 1985). Similarly, a motion picture film recording, just like a sound recording, is also a statutory article of manufacture under § 101.

The proper examination procedures for determining whether claims are eligible for patent protection under § 101 are set forth in MPEP § 2106, which states that even claims that are directed to an abstract idea are eligible for patent protection if the claimed invention is directed to a practical application. Applicants further note that the Federal Circuit just recently stated in the *In re Bilski* decision that a claim that is drawn to a particular use, a specific application, is not drawn to the principle in the abstract. A motion picture film copy or a motion picture film print bearing special marks that serve to identify the film copy or film print is very much directed to a particular use and specific practical application, and thus are eligible for patent protection under § 101.

Applicants note that the rationale for denying patent protection to inventions addressed to “a mere compilation of data” is that the essence of its novelty does not reside in a physical structure or extension, but rather in concepts conveyed by the arrangement of words or data. In contrast, the motion picture film copy or a motion picture film print embodied in claims 17-20 and 24 very much resides in the physical structure of the film copy or film print itself. The fact that marks are formed in the film copy or film print to resemble defects in the film copy or film print itself while separately serving to represent coded information clearly direct to claimed invention to particular use and specific practical application in a specific “manufacture” and are not merely “abstract” ideas.

Further evidencing the statutory eligibility for a motion picture film copy or a motion picture film print, it should be noted that the U.S. Patent and Trademark Office has consistently and repeatedly over time found that motion picture films having specific information coded thereon are patentable. Applicants initially note that U.S. Patent No. 7,206,409, which was just issued by the U.S. Patent and Trademark Office in 2007 and which was also cited by the present Examiner in the present application in an Office Action dated December 18, 2007, claims a security coded motion picture comprising a plurality of motion picture scenes that include marks. Clearly, the U.S. Patent and Trademark Office found that U.S. Patent No. 7,206,409 was not merely “a compilation of data” directed to an “abstract idea,” but rather, in issuing this patent, the U.S. Patent and Trademark Office found that a security coded motion picture comprising a plurality of motion picture scenes that include marks is indeed a statutory article of manufacture under § 101.

Still further, a very brief search of the USPTO records revealed the following additional issued U.S. patents that were directed to similar statutory articles of manufacture under § 101:

<u>U.S. Patent No.</u>	<u>Claim Recitation</u>
4,308,327	1. A motion picture release print produced by . . .
4,366,217	1. An exposed and developed motion picture release print, comprising: ...
4,577,305	1. A motion picture film having a photographic sound-track for selective reproduction of monophonic sound . . .
5,675,379	10. A recording medium having recorded thereon moving picture signals having a bit stream obtained from ...
<u>U.S. Patent No.</u>	<u>Claim Recitation</u>
5,864,368	26. A signal recording medium having recorded thereon encoded picture signals produced by ...
5,991,500	7. A video signal record medium having recorded thereon a video signal comprised of ...
7,206,409	22. A security coded motion picture disposed on a media comprising: ...
	49. A security coded motion picture comprising: a motion picture recording comprised of a plurality of frames, ...

As can be seen, in accordance with the BPAI's decision in *Ex Parte Carver* that sound recordings are eligible for patent protection under § 101 as statutory articles of manufacture, the USPTO has repeatedly found that motion picture film prints are a type of media that are eligible for patent protection. As such, Applicants respectfully submit that the claimed motion picture film copy and motion picture film print are manufactures having a practical application that clearly fall within a statutory category of patent eligible subject matter under § 101. Withdrawal of the § 101 rejection of claims 17-20 and 24 is hereby requested.

Conclusion

Applicant believes that this case is now in good condition for allowance, and an early Notice of Allowance is earnestly solicited for claims 9-15, 17-20 and 24-28. If a telephone or further personal conference would be helpful, the Examiner is invited to call the undersigned, who will cooperate in any appropriate manner to advance prosecution.

The Commissioner is directed and authorized to charge all additional required fees, except for the Issue Fee and the Publication Fee, to **Deposit Account Number 50-2638**. Please also credit any overpayments to said Deposit Account. Please ensure that Attorney Docket Number 092807-011000 is referred to when charging any payments or credits for this case.

Respectfully submitted,



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